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| APPLICATION NO.             | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.  | CONFIRMATION NO. |
|-----------------------------|-------------|----------------------|----------------------|------------------|
| 10/537,649                  | 02/28/2006  | Yoshimitsu Kagiwada  | SHIO-0110            | 4613             |
| 23377                       | 7590        | 08/04/2009           | EXAMINER             |                  |
| WOODCOCK WASHBURN LLP       |             |                      | PLUCINSKI, JAMISUE A |                  |
| CIRA CENTRE, 12TH FLOOR     |             |                      |                      |                  |
| 2929 ARCH STREET            |             |                      | ART UNIT             | PAPER NUMBER     |
| PHILADELPHIA, PA 19104-2891 |             |                      | 3629                 |                  |
|                             |             |                      |                      |                  |
|                             |             |                      | MAIL DATE            | DELIVERY MODE    |
|                             |             |                      | 08/04/2009           | PAPER            |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

|                              |                        |                     |  |
|------------------------------|------------------------|---------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |  |
|                              | 10/537,649             | KAGIWADA ET AL.     |  |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |  |
|                              | JAMISUE A. PLUCINSKI   | 3629                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 01 May 2009.

2a) This action is FINAL.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-6 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-6 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

|   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | Paper No(s)/Mail Date. _____ .                                    |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>20090528</u> . | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|   | 6) <input type="checkbox"/> Other: _____.                         |

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/1/09 has been entered.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 1-3, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tozzoli et al. (6,151,588) in view of Business Wire (Article: Retail Decision and I4 Commerce Form Alliance to Provide the Bill Me Later Payment Option for LiveProcessor Users).

5. With respect to Claim 1: Tozzoli discloses the use of a parcel delivery information exchange method (The system of Tozzoli is one that processes payments and stored billings amounts for items purchased and delivered, therefore the examiner considers the system to be fully capable of retrieving transaction state of the commodity by the parties involved in the commodity transaction, and the examiner considers the method of Tizzoli fully capable of mutually exchanging the transaction state of the commodity on a network, the method comprising:

- a. Storing commodity information in a commodity information storage means (Column 6, lines 48-52 and Claim 7);
- b. Storing a billing amount and delivery state information of the commodity in a Door-to-Door parcel delivery information storage means, (Column 8, lines 14 to 23);
  - i. With respect to the limitation of "said delivery state information including a moving state of being in the vicinity of an intersection and in the vicinity of a building", Tizzoli discloses the use of delivery state information, however fails to disclose the delivery state information including a moving state in the vicinity of an intersection and in the vicinity of a building. However, the specific type of merchandise or material is deemed to be nonfunctional descriptive material and is not functionally involved in the steps recited. The shipping steps would be performed the same regardless of what type of material is being shipped. Thus

this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed.Cir.1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994).

c. Communicating with an external device via a communications means (Reference numeral 40);

d. Mutually exchanging, on a network, a transaction state of a commodity by controlling, via a processing means, an operation of each means (20A... 20N), wherein the processing means receives the order reception information from a receiver side terminal (See Figure 2A, Column 6, lines 35-47), stores a billing amount based on the order (Column 7, lines 1-8 and Column 8, lines 15-22, the orders are associated with a price, therefore when the purchase order is accepted and stored, the examiner considers this to be the billing amount that is stored), receives and stores delivery state information from the deliverer side terminal (Column 8, lines 6-13), receives and transmits a billing amount to orderer, seller and the buyers broker (Column 9, lines 15-23). Tozzoli discloses that the order can come with a payment guarantee, therefore the system of Tozzoli is fully capable of having the commodity shipped before payment is confirmed.

6. With respect to the phrase “wherein said processing means receives information that a payment in accordance with the billing amount is completed to avoid suffering a loss due to duplicate payments at payment on delivery”: The processing means of Tozzoli disclose receiving an indication that a payment is made, therefore with respect to avoiding suffering a loss due to duplicate payments using payment on delivery, this phrase is directed towards the

intended outcome of the step of receiving information that the payment has been made.

Furthermore, the method is written in the view of the processing system performing steps.

Therefore the system is not avoiding suffering a loss by receiving the payment information, the receiver is avoiding a loss.

7. Tozzoli discloses the order can come with a payment guarantee, however fails to specifically disclose an order receiver then ships the commodity to a user of the receiver side terminal before confirming payment with the receiver side terminal. The Business Wire article discloses the use of catalog and website order receivers using an option of "Bill Me Later" which is a method of shipping a product to the customer before payment is received (See Page 1). The examiner considers this to be the order receiver shipping the commodity to a user of the receiver side terminal before confirming payment with the receiver side terminal. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Tozzoli to include the "Bill Me Later" feature as described in the Business Wire article, in order to eliminating the need for a credit card at purchase and enables merchants to reduce transaction costs (See Business Wire article, Page 1)

8. With respect to Claim 2: Tozzoli discloses the use of shipping document templates, which the examiner considers to be a form of a shipping slip. Figure 3A discloses the system to store templates, use deliverer information and prepare the shipping documents and forward them to the seller to finalize the terms (See Figure 3A, Reference numerals 610, 620, 630 and 850 with corresponding detailed description).

9. With respect to Claims 3 and 5: See Figure 3C with corresponding detailed description.

10. With respect to Claim 6: See Reference numerals 640 and 870 with corresponding detailed description.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozzoli et al. and Business Wire in view of Kadaba (6,539,360).

12. Tozzoli and The Business Wire article, disclose the use of shipping orders, however fails to disclose the items of the order are fragile articles or pets, and fails to disclose the delivery status is a state of the article or the pet. Kadaba discloses the use of a special handling item shipping and tracking system, which ships and tracks whether a package designated for special handling (such as fragile items, Column 6, lines 1-8) has been applied to the packages (See abstract). It would have been obvious to one having ordinary skill in the art at the time the invention was made, to modify Tozzoli and Business Wire to include the tracking of special handling items, such as in Kadaba in order to provide a system which applies special handling to fragile items at appropriate times and to determine if there is a reoccurring failure in the special handling of items. (See Kadaba Column 4).

### ***Response to Arguments***

13. Applicant's arguments filed 5/1/09 have been fully considered but they are not persuasive.

14. With respect to applicant's argument that the prior art does not teach determining a billing amount that is based on order reception information and delivery state information that includes a moving state of being in the vicinity of an intersection and building, and due to the fact that the

claims have been amended to become a method, the information is not intended use. However, as stated above, the examiner considers the delivery state information being a moving state of being in the vicinity of a building or an intersection is in fact non-functional descriptive information. The claims simply store and display the information, and the storing and displaying steps can be done the same regardless of what kind or what granularity of information the delivery state information is. The determining is based on delivery state information, but it is not being determined based on the vicinity, intersection and building information, therefore the specific information is not positively utilized in any of the steps, therefore is considered to be non-functional descriptive.

15. With respect to the phrase “to avoid suffering a loss”: This step, the examiner considers to be the intended outcome of the receiving information that a payment is complete step. “Bill me Later” is not intended to collect on delivery, therefore would not teach against avoiding the loss of duplicate payment. The applicant has attempted to appear to positive claim, avoiding suffering a loss, however it should be noted that due to the fact that Fizzoli and “Bill Me Later” do not disclose collecting payment on delivery, then they inherently avoid collecting double payment.

16. With respect to Applicant’s argument that the office action states that it is comment for a delivery slip has an amount owed and an amount paid. The applicant has attempted to traverse this statement, however has not properly done so. In order for the applicant to properly traverse an official notice or a common knowledge statement, the applicant needs more than to just state that they traverse, but give reasoning on why it is not common knowledge or old and well known

in the art. Is the applicant stating that it is not old and well known in the art to have the amount owed and amount paid on a delivery slip?

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMISUE A. PLUCINSKI whose telephone number is (571)272-6811. The examiner can normally be reached on M-Th (5:30 - 4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jamisue A. Plucinski/  
Primary Examiner, Art Unit 3629

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